

ESTTA Tracking number: **ESTTA701642**

Filing date: **10/12/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85913125
Applicant	The National Association of Professional
Applied for Mark	HOUSTON BUFFS
Correspondence Address	KATHRYN A COMELLA FROST BROWN TODD LLC 10 W BROAD ST, STE 2300 COLUMBUS, OH 43215 UNITED STATES trademarks@fbtlaw.com, squimby@fbtlaw.com, sross@fbtlaw.com, fbtiplitigation@fbtlaw.com, kcomella@fbtlaw.com
Submission	Applicants Request for Remand and Amendment
Attachments	MiLB_Request for Remand re HOUSTON BUFFS and design.pdf(545002 bytes)
Filer's Name	Kathryn A. Comella
Filer's e-mail	kcomella@fbtlaw.com, fbtiplitigation@fbtlaw.com, squimby@fbtlaw.com
Signature	/kathryn a comella/
Date	10/12/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:

Serial No.: 85/913,125

Mark: HOUSTON BUFFS and design



Applicant: The National Association of Professional Baseball Leagues, Inc.

Filing Date: April 24, 2013

Trademark Attorney: Alison F. Pollack

Law Office: 106

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box. 1451
Alexandria, Virginia 22313-1451


REQUEST FOR REMAND

Pursuant to § 1207.02 of the Trademark Trial and Appeal Board Manual of Procedure (the "TBMP"), Petitioner The National Association of Professional Baseball Leagues, Inc. ("Minor League Baseball" or "Applicant") hereby requests the Trademark Trial and Appeal Board (the "Board") to continue to current suspension of the appeal and remand the application for further examination for additional evidence. Minor League Baseball believes good cause exists to support the requested remand as it has secured a consent agreement with the owner of the registered marks cited against the relevant application.

MEMORANDUM IN SUPPORT

In light of the recently obtained consent agreement, Applicant respectfully asks the Board to continue the current suspension of the appeal and remand the application for additional evidence.

I. Background

Minor League Baseball owns Application Serial No. 85/913,125 for  "HOUSTON BUFFS and design" in Class 25 for use with "[b]aseball related clothing, namely, caps, and t-shirts sold to promote the nostalgia of historic baseball teams that existed within Minor League Baseball[.]" During the prosecution of HOUSTON BUFFS and design, the Examining Attorney refused to register the mark on the grounds that it was likely to cause confusion with various marks owned by The Regents of the University of Colorado ("CU"). Applicant then asked the Board to suspend the instant appeal to give it more time to negotiate a consent agreement with CU. The Board suspended the appeal in light of the consent agreement discussions.

Now Minor League Baseball is happy to report it has secured a consent agreement with regard to the HOUSTON BUFFS design mark application, attached as Exhibit A, and respectfully asks the Board remand the application in light of this additional evidence.

II. Law & Argument

A request to remand for additional evidence must include a showing of good cause and be accompanied by the additional evidence sought to be introduced. TBMP § 1207.02. The Board provides examples of circumstances that have been found to constitute good cause for remand for additional evidence, including where the evidence was not previously available. In addition, the Board astutely points out:

[B]ecause a consent agreement offered in response to a refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d), is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability, **the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board's final decision on the appeal.**

Id. (Emphasis added and internal citations omitted).

Minor League Baseball requests the Board continue to current suspension the appeal and remand the application for consideration of its recently obtained consent agreement. *See* Ex. A. Further, Minor League Baseball notes the instant motion is filed prior to the Board's final decision on the Appeal. Accordingly, Minor League Baseball respectfully asserts good cause exists and asks the Board to grant its Request to Remand.

Respectfully submitted,

The National Association of Professional Baseball
Leagues, Inc.

Date: 10/12/15

By: 

Samantha M. Quimby, Esq.
Kathryn A. Comella, Esq.
FROST BROWN TODD LLC
10 West Broad Street, Suite 2300
Columbus, Ohio 43215
Telephone: (614) 559-7281
Facsimile: (614) 464-1737

*Attorneys for The National Association of
Professional Baseball Leagues, Inc.*

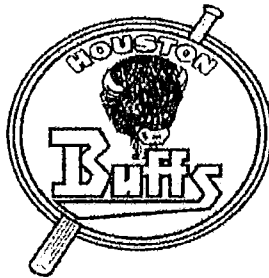
Exhibit A

CONSENT AGREEMENT

This Consent Agreement ("Agreement"), made this 16th day of July, 2015, is by and between The National Association of Professional Baseball Leagues, Inc. ("Minor League Baseball" or "MiLB") and The Regents of the University of Colorado, a body corporate ("CU");

WHEREAS, CU is the owner of all right, title and interest in and to the trademarks BUFFS, FOREVER BUFFS and BUFFS 4 LIFE (collectively, the "CU Buffs Marks") and these marks are the subject of U.S. Registration Nos. 4405845; 4301429; 3939747 and 3634016, all for use in connection with entertainment services in the nature of college sports as well as various clothing apparel, novelty items, club and charitable services that are offered and sold in connection therewith;

WHEREAS, Minor League Baseball is the owner of U.S. Trademark Application Serial No. 85/913,125 for the following design mark:



for use in connection with Baseball related clothing, namely, caps, and t-shirts sold to promote the nostalgia of historic baseball teams that existed within Minor League Baseball (the "Houston Buffs Mark");

WHEREAS, due to the actual difference in the marks, the fact that the Houston Buffs is now a defunct baseball team whose history is kept alive through Minor League Baseball's sale of vintage baseball clothing apparel, and the differences in the commercial context within which a consumer would view and or otherwise encounter the marks, the parties believe that there is no likelihood of confusion, mistake, or deception between the marks identified above;

NOW THEREFORE, in consideration of the promises herein exchanged, the parties agree as follows:

1. *Consent to Register.* CU hereby consents to Minor League Baseball's registration of the Houston Buffs Mark for the goods listed in U.S. Trademark Application Serial No. 85/913,125.
2. *Covenants to Avoid Likelihood of Confusion.* Both parties agree to not represent that its goods originate from, are sponsored by, or are affiliated with the other party. Specifically, the Parties agree as follows:

2.1 MilB will not expand use of the Houston Buffs Mark beyond apparel and other novelty items (e.g., baseball trading cards; bobble heads) offered to promote the nostalgia of the historic baseball team known as the Houston Buffs;

2.2 MilB will refrain from using the Houston Buffs Mark or any trademark consisting of or that includes the term "BUFF," "BUFFS," "BUFFALO" or "BUFFALOES" (or any variations of these terms, including misspellings) for any services or goods related to collegiate level sports.

2.3 Other than the currently pending Application for the Houston Buffs Mark, MilB will refrain from:

2.3.1 filing any other trademark application for the Houston Buffs Mark;

2.3.2 filing any new trademark application that either: (a) consists solely of a buffalo design or caricature; (b) consists solely of the term "BUFF," "BUFFS," "BUFFALO" or "BUFFALOES" (or any variations of these terms, including misspellings), or (c) consists of a combination of (a) and (b); provided however, that nothing shall prevent MilB from applying for such terms or designs provided that such term or design contains additional terms, verbiage, or design elements that identify a particular MilB team or league. Any such applications would be limited to goods and services in promotion of Minor League Baseball and would not be used in connection with any collegiate level sports.

2.4 In the unlikely event that the parties become aware of instances of actual confusion, notwithstanding the terms of this Agreement, the parties agree to cooperate to resolve the confusion and to avoid further instances of such confusion.

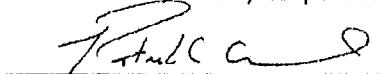
3. *Covenant not to Challenge.* MilB expressly recognizes and acknowledges CU's rights in the CU Buffs Marks, and Buffalo Design Mark shown below, for use in connection with the educational and entertainment services, as well as promotional merchandise offered in connection with such services (collectively, the "CU Marks") and will not directly or indirectly object to, challenge, or oppose CU's use or registration of the CU Marks or any mark containing the CU Marks.



Conditioned on and subject to MiLB's compliance with the terms of this agreement, CU will not directly or indirectly object to, challenge, or oppose, MiLB's use or registration of the Houston Buffs Mark or any other mark compliant with Section 2.3.2.

4. *Further Documents.* The parties agree to take any further actions and execute any further agreements needed to carry out the spirit and intent of this Agreement, if necessary.
5. *Binding Effect.* CU expressly understands that MiLB does not have the authority to bind any existing baseball team or club that operates within the association of Minor League Baseball, regardless of whether or not MiLB acts as agent or counsel to such team or club. As such, it is understood and agreed that this Agreement is not binding on any entity other than The National Association of Professional Baseball Leagues, Inc. dba Minor League Baseball. Notwithstanding the foregoing, this Agreement shall be binding upon and inure to the benefit of the parties, their respective successors and assigns, subsidiaries, affiliates, licensees, or related companies owned or otherwise controlled by the parties.
6. *Entire Agreement.* This Agreement constitutes the final and complete expression of all the terms of the agreement between the parties. It supersedes all understandings and negotiations concerning the matters specified herein. Any representations, oral statements, promises, or warranties made by either party that differ in any way from the terms of this Agreement shall be given no force or effect. No addition or modification of any provision of this Agreement shall be binding unless made in writing and signed by a duly authorized representative of each of the respective parties.

THE REGENTS OF THE UNIVERSITY
OF COLORADO, a body corporate

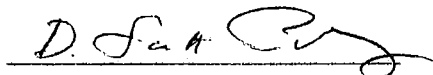


By: Patrick T. O' Rourke

Title: Vice President, University Counsel
and Secretary of the Board of Regents

Date: 7-16-15

THE NATIONAL ASSOCIATION OF
PROFESSIONAL BASEBALL LEAGUES, INC.



By: D. Scott Poley

Title: SVP Legal Affairs and
Corporate Secretary

Date: 7-16-15